



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CFP-1842-1 (15722/471CIP)

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on February 27, 2006Signature Alan D. KamrathTyped or printed name Alan D. Kamrath

Application Number

10/814,565

Filed

March 31, 2004

First Named Inventor

Arlo H. T. Lin

Art Unit

3749

Examiner

Alfred Basichas

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

28,227

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

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2/27/07

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒*Total of 3 forms are submitted.

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Attorney Docket No.15722/471CIP

Client Docket No. CFP-1842~1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re App : Arlo H. T. Lin : Confirmation No. 6890
Serial No. : 10/814,565 : Group Art Unit 3749
Filed : March 31, 2004 : Examiner Alfred Basichas
For : CIGARETTE LIGHTER WITH ALARM

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C.F.R. 1.8a).

Alfred Basichas

APPEAL CONFERENCE REASONS

Dear Sir:

Examiner Basichas recognizes that Kuriyama does not meet the recitations of the claims as it does not recite:

- A) the message as audible (with Examiner Basichas relying upon the Simenko reference to meet this deficiency, which for purposes of appeal is not being contested); or
- B) the claimed duration (one round as recited in claims 1 and/or 13)

In attempting to fill this admitted deficiency, Examiner Basichas contends:

As regards having only one round of the audible message, it is a **matter of design choice** based on esthetic appeal. The particular message and duration is simply a matter of personal preference. In view of the **absence of criticality** for this particular design, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate it into the invention disclosed by Kuriyama in view of Semenka, so as to provide for the desired esthetics (emphasis added).

In the Amendment filed on October 10, 2006, the applicant pointed out that “matter of design choice” and “absence of criticality” are improper to support an obviousness rejection. Particularly, as to design choice, as stated by the Patent Office Board of Appeals in Ex parte

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Dere, 118 USPQ 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on opposing edges spaced according to the metric or English systems respectively. The examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

'is not seen to provide a patentable distinction, being no more than a matter of choice.'

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a 'choice' available.

In view of the fact that claimed relationship has the useful advantages already enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as In re Newell, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on the citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Particularly, as set forth in In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

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The failure of the Examiner to in any way support that any other “design choice” or that any other “personal preference” as to duration is suggested by the prior art is a clear indication that the present invention is not obvious in view of the prior art.

Similarly, as to being critical, the Board of Appeals in Appeal No. 94-4450 in Application No. 07/945,247, now U.S. Patent No. 5,491,925, stated:

The limitations in appellant's claims cannot simply be dismissed “since no showing of criticality has been made” (answer, page 2 and final rejection, page 3). It is not a prerequisite to patentability that the limitation in a claim be “critical”. See W. L. Gore & Associates, Inc. vs. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Examining the Gore decision, the Court of Appeals for the Federal Circuit held:

Garlock 's appeal argument that the '390 claims are invalid because the recited minimum matrix tensile strengths are not “critical”” is without merit. A claim to a new product is not legally required to include critical limitations. (case citation)

Thus, even if the limitations are not critical as contended by the Examiner, does not mean the present invention is obvious over the prior art.

The rejection of the office communication of November 29, 2006 is word-for-word the rejection of June 5, 2006. In reply to the above showing, the Examiner states in its entirety:

Applicant's arguments with respect to the claim have been considered but are not deemed persuasive. It appears that applicant is arguing that the rejection is improper because the examiner has required a showing of criticality to overcome the obviousness rejection based on design choice. The examiner disagrees with applicant's position (emphasis added).

To what part and how does the Examiner disagree? It would be assumed that if the prior art in any way suggested that a “choice” of duration existed or that duration could be a “personal preference”, Examiner Basichas would have answered the substance of applicant's argument in a

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manner required by MPEP § 707.07(b). Since the applicant's arguments are not questioned, it must be assumed that the prior art does not support the Examiner's contention and the rejection is improper. Favorable reconsideration is respectfully requested.

Respectfully submitted,

Arlo H. T. Lin

A handwritten signature in black ink, appearing to read 'Alan D. Kamrath', written in a cursive style.

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